



065855.0199

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Linde et al.

Serial No. : 10/006,600

Group Art Unit: 3627

Filed : December 5, 2001

Examiner: Andrew J. Rudy

Title: METHOD FOR DETERMINING THE POST-LAUNCH
PERFORMANCE OF A PRODUCT ON A MARKET

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I hereby certify that this paper is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

on January 8, 2007

Date of Deposit

Manu J. Tejwani

37,952

PTO Registration No.

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request review of the more than twice rejection of the
claims in the above-identified application, and present the following Remarks for
consideration. A Notice of Appeal is being filed with this request.

REMARKS

Pending claims 1-3 have been rejected under 35 U.S.C. § 103(a) as being obvious from Delugrio et al. U.S. patent No. 7,092,896 B2 (“Delugrio”) and 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse these rejections.

With respect to the 35 U.S.C. § 112 rejection, the phrase “related to” is clear and definite. The phrase is readily understood in common and scientific usage to mean “associated with,” “corresponding to,” or “function of” (which meanings and usage, applicants respectfully note, are prevalent in the cited art, and remain unchanged through four previous Office Actions in which the phrase was not found indefinite). Applicants request an Examiner’s Amendment to claim 1 lines 3, 5 and 7 as follows: “data ~~related to~~ on”, if the Review Panel finds such Amendment useful.

Prior art rejection

Applicants’ invention, according to claim 1, relates to a process for an analytical evaluation of a product marketing effort for a “specific” product in the context of the presence of several competitive products on the market. The subject product may, for example, be a new pharmaceutical drug. In particular, claim 1 includes the steps of assembling databases of various market data specific to products including (1) data related to a success factor in a market performance of the subject product (e.g., success factors such as product detailing, adoption and capture rates); (2) data on unmet or latent product needs in the market; and (3) data on the proclivity of decision makers (e.g., prescribing physicians, insurance and hospital personnel) to choose the subject product over other products. Claim 1 further includes (4) the step of using a computer simulation model to

project a future market share of the specific subject product based on the market product data assembled in steps (1) (2) and (3).

Applicants note that the Examiner has improperly rejected claims 1-3 under 35 U.S.C. § 102 or § 103 over several Office Actions by failing to identify claim elements alleged to be anticipated and by failing to make out a prima facie case of obviousness. In particular, applicants respectfully submit that in the present Office Action claims 1-3 have been improperly rejected (as being obvious from Delugrio) without establishing a prima facie case of obviousness. (See Office Action, § 4 pages 2-3).

To establish a prima facie case of obviousness under §103(a), according to MPEP § 2143, three basic criteria must be met: (a) some suggestion or motivation to modify Delugrio; (b) a reasonable expectation of success; and (c) a teaching or suggestion of all the elements of claims 1-3.

Applicants also respectfully note, according to MPEP § 2124 “[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).”

The §103(a) rejection of claims 1-3 in the Office Action does not address or satisfy any of the three criteria required to establish a prima facie case of obviousness.

Careful reading indicates Delugrio does not have any disclosure (explicit or

inherent), which shows, teaches, suggests, or motivates applicants' inventive quantification of the post launch market share of a specific product which is the subject of a marketing effort.

Unlike applicants' inventive process, Delugrio is not concerned with specific product marketing (e.g., by a product supplier or manufacturer), or with any numerical calculation or projection of a market share of a subject product. Instead, Delugrio relates to overall store promotion strategies for products within a product category by a store category manager. (See e.g., col. 2 lines 34- col. 3 line 46). Delugrio describes optimizing promotion plans over a group of products to maximize net store profit taking into account demand chain costs associated with each of the products in the group (See e.g., col. 3 line 50- col. 4 line 11, FIG. 1, etc.). Delugrio describes balancing a choice of promotional events 101, a choice of supplier offers 102, and promotion constraints 103 to output an optimized promotion plan 104 to maximize profit for a store selling a category of products. (See e.g., col. 5 line 35- col. 6 line 34, etc.).

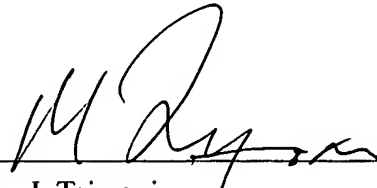
Applicants respectfully submit that Delugrio does not show, teach or suggest the elements of claims 1-3. For example, with respect to claim 1, there is no teaching or suggestion in Delugrio of the steps of assembling "data on unmet or latent product needs in the market"; and "data on the proclivity of decision makers (e.g., prescribing physicians, insurance and hospital personnel) to choose the subject product over other products." Further, Delugrio does not teach or suggest the step of using a computer simulation model to project a future market share of the specific subject product. For at least this reason, the Office Action fails to make a prima facie case of obviousness.

PATENT

Applicants respectfully further note that the Examiner (See Office action end of § 4, page 4) mistakenly generalizes all product marketing data to be the same, and mistakenly asserts that Delugrio's databases 101 102, and 103 correspond to or include (2) data on unmet or latent product needs in the market; and (3) data on the proclivity of decision makers, as required by claim 1. (See Office Action a page 4). Applicants also note that there is no suggestion in Delugrio (or otherwise in the art) directing a person in the art to modify Delugrio's disclosure (which is directed to store managers for maximizing net store profit) to arrive at applicants' invention for projecting a future market share of the specific subject product. Applicants note that the Office Action improperly uses hindsight based on applicants' disclosure to ascribe the claimed steps to Delugrio.

For at least the foregoing reasons, the prior art rejections of claims 1-3 should be withdrawn.

Respectfully submitted,



Manu J. Tejwani

PTO Reg. No. 37,952

Attorneys for Applicants

Baker Botts L.L.P

30 Rockefeller Plaza

New York, NY 10112

212-408-2614